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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,900	11/23/2001	Parag Gokhale	4982/23	3389

25096 7590 04/11/2008

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EXAMINER	
CHEN, TE Y	
ART UNIT	PAPER NUMBER
2161	
MAIL DATE	DELIVERY MODE
04/11/2008	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PARAG GOKHALE, RAJIV KOTTOMTHARAYIL,
and SRINIVAS KAVURI

Appeal 2008-1254
Application 09/991,900[1]
Technology Center 2100

Decided: April 11, 2008

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, C., *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] Application filed November 23, 2001. The real party in interest is CommVault Systems, Inc.

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-20 entered January 20, 2006. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

A. INVENTION

Appellants invented a system, method, and computer readable medium for exporting media in a library according to a scheduled second time. (Spec., Abstract.)

B. ILLUSTRATIVE CLAIM

The appeal contains claims 1-20. Claims 1, 12 and 18 are independent claims. Claim 1 is illustrative:

> 1. A method for exporting removable media in a storage device according to a schedule, comprising:
>
> at a first time, receiving export identification data comprising first data identifying one or more removable media from the storage device to be exported and second data identifying a second time at which the one or more removable media is scheduled to be exported;
>
> storing the export identification data in a data file; and
>
> at the second time, using the stored export identification data to select the one or more removable media to be exported to export the selected media from the storage device library.

C. REFERENCES

The references relied upon by the Examiner in rejecting the claims on appeal are as follows:

Crouse	US 5,764,972	Jun. 9, 1998
Baca	US 5,898,593	Apr. 27, 1999

D. REJECTION

The Examiner entered the following rejection which is before us for review:

Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Crouse in view of Baca.

II. PROSECUTION HISTORY

Appellants appealed from the Final Rejection and filed an Appeal Brief (App. Br.) on March 19, 2007. The Examiner mailed an Examiner's Answer (Ans.) on July 17, 2007. Appellants filed a Reply Brief (Reply Br.) on September 17, 2007. A telephonic Oral Hearing was held at the U.S. Patent and Trademark Office on April 8, 2008.

III. ISSUE

Whether the combination of Crouse and Baca would have suggested exporting media according to a scheduled second time.

IV. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Baca

1. Baca discloses "an automated data storage library for storage, retrieval, selective export and import of portable data storage media, at least some of the media stored in storage cells of portable magazines." (Col. 2, ll. 3-6.)

2. In Baca, "the library controller 82 is able to employ a cartridge identifier in a command from a host 85 to identify the magazine containing the cartridge, and the storage slot location of the cartridge, determine the location of any cartridge in a drive, and the current position of the pickers. This information is used in conjunction with job queue contents by the library manager to schedule picker moves and to schedule the export of selected magazines." (Col. 6, l. 62 to Col. 7, l. 3.)

3. Baca discloses that "[w]hen a magazine is required to be exported, the host will instruct the operator that a selected magazine is ready to be exported and indicate the column 90 or 91 which has the selected magazine." (Col. 7, ll. 43-46.)

V. PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) wherein evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

VI. ANALYSIS

Common Feature In All Claims

Our illustrative claim presented *supra*, claim 1, recites, *inter alia,* "at a first time, receiving . . . second data identifying a second time at which the one or more removable media is scheduled to be exported." Independent claims 12 and 18 recite similar limitations. Thus, the scope of each of the independent claims includes "the exportation of selected removable media at a second time."

The Obviousness Rejection

We now consider the Examiner's rejection of claims 1-20 under 35 U.S.C. § 103(a) as being obvious over the combination of Crouse and Baca.

The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently . . . ." *In re Zurko*, 258 F.3d 1379, 1383 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995)). "In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

The Examiner found that "Crouse did not specifically disclose at the second time, the file input/output commands including a scheduling of an exporting processing." (Ans. 4.) Instead, the Examiner relies upon Baca for this limitation and found that Baca "discloses a data storage system to automatically scheduling [sic] an import and export I/O commands for removable devices at the second time." (Ans. 5.)

Appellants contend that "Baca does not disclose exporting media according to a schedule, as described in claim 1." (App. Br. 8.) Appellants further contend that:

> [T]he "scheduling" in Baca relates to coordinating specific internal operations in the library, such as moving a picker and rearranging stacks of magazines so that a desired magazine is on top of a stack for exporting. The "scheduling" in Baca does not disclose "identifying a second time at which the one or

more removable media is scheduled to be exported" as recited by the claim.

(App. Br. 8-9.) We agree.

Baca discloses an automated data storage library that performs selective export and import of portable data storage media (FF 1). In Baca, a library controller receives a cartridge identifier in a command from a host and uses this information in conjunction with the job queue contents to schedule the export of selected magazines (FF 2). Baca's host instructs the operator that a selected magazine is ready to be exported and indicates the column that has the selected magazine (FF 3).

In other words, we find that while Baca discloses selectively exporting data storage media using an identifier found in a command from a host in conjunction with job queue information, the Examiner has not shown, and we do not readily find where Baca makes up for the deficiencies of Crouse and discloses receiving a second time and at the second time exporting the selected media from the storage. Instead, Baca relies in part on the job queue list to determine the exportation time, which is in essence a time dictated by "as soon as possible". We find that a "time" hinging on "as soon as possible" is distinguishable from "second data identifying a second time at which the one or more removable media is scheduled to be exported," as recited in the language of independent claim 1.

Since we agree with Appellants that the Examiner has not supported the rejection of the noted claims with a teaching or suggestion from the cited prior art, and as the above-noted arguments affect all the appealed claims, it is not necessary at this time to address the further arguments made by Appellants (e.g., App. Br. 10 and Reply Br. 5).

Therefore, we will *not* sustain and will instead reverse the Examiner's rejection under 35 U.S.C. § 103(a) for the same reasons as set forth above.

VII. CONCLUSION

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-20.

VIII. DECISION

In view of the foregoing discussion, we reverse the Examiner's rejection of claims 1-20.

REVERSED

clj

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